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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,196	08/23/2001	Yutaka Takahashi	100725-00051	8768

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EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/935,196	TAKAHASHI ET AL.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/14/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

Claims 1-9 (system/apparatus claim, 1 independent and 8 dependent claims) are pending and are rejected as followed. The finality of the previous Office action of 3/15/06 is hereby withdrawn.

Claim Rejections - 35 USC § 112

1. Claims 1, 5, 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 1, lines 8-9, the phrase "... providing technical information required to select said mechanical component" is vague and indefinite because it's not clear (1) providing for whom? And (2) how could such "information" be provided such as to force an action of "selecting a component" and by whom?

(2) Claims 8-9 recites the limitation "the inquiry" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over VOROBIEV (US patent 6,651,063).

As of 12/2/2005, claim 1 is as followed:

1. (Currently Amended) A marketing support system for allowing a supplier, which manufacturers and sells to at least one sales agency a mechanical component having a rolling element and a sliding bearing, to support the at least one sales agency selling said mechanical component to a purchaser, wherein

a communication device of the supplier is connected to an open network and comprises:

technical information service means for providing technical information required to select said mechanical component; and

sales agency introduction means for introducing the at least one sales agency selling said mechanical component, and

a communication device of the at least one sales agency is connected to the open network and comprises:

order processing means for taking an order from the purchaser to purchase the mechanical component and for electronically processing the purchase order, and

wherein

the purchaser accesses the communication device of the supplier over the open network to select and purchase the mechanical component from one of the at least one sales agency.

As for independent system (apparatus) claim 1, in a similar system for marketing support system {see Fig. 1 (10)}, **VOROBIEV** discloses:

(a) a communication device of the supplier is connected to an open network (Internet) and comprises {see Fig. 4, 310, (314)}:

(a₁) technical information service means for providing technical information; {see col. 6, lines 27-30 "... *Provider 14 sends information to the desired Recipient's User* ...", col. 10, lines 32-37 "... send information to Users ... generated by, the original source of the goods such as a Manufacturer 42 ...", col. 14, lines 2-60, ". visitor 212 may request information about ... products", Fig. 1. (14, 18, 42), Fig. 4, 320} and

(a₂) sales agency introduction means for introducing the at least one sales agency selling said mechanical component {see Fig. 4, 322A "DYNAMIC INFORMATION, (ORDERING, SHIPPING), col. 16, lines 1-60, "car" or "Model 1 CD player" as "mechanical component"}, and

(b) a communication device of the at least one sales agency is connected to the open network and comprises {SEE Fig. 5, (414), (422)}

(b₁) order processing means for taking information (order) from the purchaser to purchase the mechanical component and for electronically processing the purchase order {see Fig. 4, 322A "DYNAMIC INFORMATION, (ORDERING, SHIPPING), col. 16, lines 1-65, col. 17, 1-37}.

Note that the phrase "required to select said mechanical component" followed "information" of (a₁) is considered as non-functional description material and thus having

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no patentable weight. Furthermore, this non-functional description material feature is taught in Fig. 4, 320A, 322A, col. 15, line 65 to col. 16, line 20.

Note on col. 16, lines 48-60, VOROBIEV discloses the integration of system 310 of Fig. 4 with the system 410 of Fig. 5 which would produce the same results as in the above claim since it combines both the system of Fig. 4 and 5 which connect the three entities, (1) supplier or provider or manufacturer, (2) dealer or sales agency and (3) customer or purchaser (recipient), together over a wide open communication network, Internet, whereby they can exchange information (communication) and the recipient or customer can make order and purchase the mechanical component (car/automobile).

Note that in an apparatus claim, only features of the apparatus that are recited either structurally (device) or functionally (means for ...) have patentable weight. See *In re Schreiber*, 128 F. 3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32. Manner of operating the device or intended use of the system does not differentiate apparatus claim from the prior art.

Note the limitation "for allowing ... to a purchaser" in the preamble merely recites the intended use of the system, thus having no patentable weight.

Note that the last phrase ".... wherein the purchaser accesses the communication device of the supplier over the open network to select and purchase the mechanical component from one of the at least one sales agency" has no patentable weight in a system/apparatus claim because it has no elemental structure. This is considered as the manner of the operating device. Moreover, this is taught in col. 16,

lines 1-20 "... advertising or promotions directed toward eventual purchases of cars in which the Model 1 CD players are installed..".

Alternatively, the selection of any other type of mechanical component or the type of the mechanical component, which is non-essential to the scope of the claimed invention which is applicable to any tool or mechanical component, is considered as selection of other similar/equivalent material using the same process to achieve similar results and would have been obvious to a skilled artisan. Note on column 20, lines 7-12, VOROBIEV discloses "... that many variations and equivalents are possible, and are extended to be within the scope of the claims".

As for dep. claims 2-3 (part of 1 above), which deal with method steps for doing thing by the purchaser or supplier and do not have either structurally elements (device) or functionally (means for) elements, they have no patentable weight in an apparatus claim. Moreover, these concepts are taught in col. 16, lines 1-22 or Figs. 4 and 5.

As for dep. claims 4-5 (part of 1/3 above), which deal with further limitation of the supplier communication device, i.e. receiving information (inquiry) from the customer about a product, VOROBIEV teaches interactive communication and Feedback communication between various parties, see col. 4, lines 28-67, Example 2 as shown on col. 14, lines 2-25, 58-67, Fig. 3 (212) "REQUEST PRODUCT INFORMATION", "COMMUNICATE TO INFORMATION PROVIDERS", Figs. 4-5, Dynamic information, with the term "visitor" inherently means recipient or customer or purchaser.

Alternatively, it would have been obvious to replace the term visitor 212 in Example 2 as recipient or purchaser (412) of Fig. 5 as mere changing the name of the recipient or

entity who communicates with the manufacturer or vendor and makes a purchase of the component which he/she requests information thereof.

Note that in dep. claim 4, the phrase "... contents of the inquiry ... the appropriate sales agency processes the purchase order" and non descriptive functional and merely method steps having no elemental or functional structure, thus having no patentable weight in an apparatus claim.

Note that in dep. claim 5, the phrase "... and allowingto the purchaser" is merely method step, thus having no elemental or functional structure, and therefore have no patentable weight in an apparatus claim.

As for dep. claim 6 (part of 1 above), which deal with well known features of the sales agency introduction means (dealer), i.e. name, item, address of the sales agency (dealer), etc., these are taught in Fig. 5, (424) "*Name of dealership, address, phone*".

As for dep. claim 7 (part of 1 above), which deal with method step for doing thing and do not have either structurally elements (device) or functionally (means for) elements, they have no patentable weight in an apparatus claim. Moreover, this is well known or conventional practice and would have been obvious to do so and/or is inherently included in the teachings of VOROBIEV as indicated in Fig. 4, (322A "shipping, account balance).

As for dep. claims 8-9 (part of 1 above), which deal with method step for doing thing and do not have either structurally elements (device) or functionally (means for) elements, they have no patentable weight in an apparatus claim. Moreover, these features are fairly taught col. 3, lines 10-60, col. 9, lines 1-10.

Note that on col. 20, lines 7-12, or last paragraph, VOROBIEV discloses that its invention has been disclosed with respect to certain preferred embodiments and particular examples, those skilled in the art (such as the inventors), will recognize that the invention can be practiced with modifications or variations and equivalents (i.e. types of requesting information or components, communication between entities, etc. to meet certain specific conditions), as shown in dependent claims 2, or 3 or 4) and are intended within the spirit and scope of the claims (or are obvious), without objective secondary evidence (see 103 obvious tests on paragraph 4, item 4). No objective secondary evidence has been shown.

No claims are allowed.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
October 25, 2006


DEANT. NGUYEN
PRIMARY EXAMINER